



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,228	04/02/2001	Hirofumi Nakayasu	010273	6723

38834 7590 04/20/2006

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP
1250 CONNECTICUT AVENUE, NW
SUITE 700
WASHINGTON, DC 20036

EXAMINER

DIVINE, LUCAS

ART UNIT PAPER NUMBER

2625

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/822,228	Applicant(s) NAKAYASU ET AL.	
	Examiner Lucas Divine	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/28/06 has been entered.

Response to Amendment

2. Claims 19 – 36 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 19-34 are rejected under 35 U.S.C. 112, first and second paragraphs, as failing to comply with the written description requirement and as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

Art Unit: 2625

application was filed, had possession of the claimed invention. The claims (19 herein as example) recite retrieving and sending to the client a nearest 'printing agent printer site' and then goes on to retrieve the most recently used 'printing agent printer sites' and then receiving 'printer agent printing site' and the printing at the selected 'printer agent printing site'. Thus the client receives both the nearest and the predetermined number list of recently used in the same session. This is not taught in the specification and is deemed to be new matter. Further, it is unclear to what the user is selecting to be printed at, because the client specifies the site already in the 4th limitation as well as the last, which does not make much sense to the examiner as to what is being claimed and the support is lacking for this in the disclosure. Also, the language 'printer agent printing site' and 'printing agent printer site' is changed around a few times to make it unclear if these are two distinct type of things or if applicant is referring to the same entity. Clarification and adequate support is needed for these claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 19, 20, 21, 23, 28, 30, 35, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka (6522971) in view of Fritsch (US 6247130).

Regarding claim 36, Tanaka teaches a **printing agent service system** (Fig. 1),
comprising:

Art Unit: 2625

a database (Fig. 2 shows the databases located at the central service center that has information on the sites in the system, col. 3 lines 24-30) **for storing printing agent printer sites** (sites 3, Fig. 1); **and**

a server (service center 2; col. 3 lines 2-6) **for receiving a user ID** (registration code and password for example; col. 55 line 57), **a print request** (col. 1 lines 26 and 62, col. 3 lines 36-45, wherein printing is based on a user request, col. 4 lines 52-57 and 64, col. 6 line 47, wherein printed output is generated based on user print request) **and location information from a client terminal** (col. 4 lines 36-37 and 9-10), **and retrieving, from the database** (col. 4 lines 33-40), **the printing agent printer site nearest to the location of the client terminal in accordance with said location information** (Figs. 11A and 11B show the closest requested services to a user after it has been determined based on the user location; col. 8 lines 13-22),

wherein the server sends information of the nearest printing agent printer site to the client terminal for display (Figs. 11A and 11B, col. 8 lines 14-22),

receives from the client terminal a specified printing agent printer site (col. 8 lines 31-32), **and sends the print request to a printer at the specified printing agent printer site** (col. 4 lines 52-57, where a type of service that is used is printing and specifically line 52, where the data is sent from the server to the station – also col. 6 lines 48-52) , **and**

While Tanaka teaches logging into the server system (Fig. 6, col. 5 lines 10-17 of Tanaka) with user information (registration code and password for example; col. 55 line 57) as well as teaching having the user history of the user stored at the server in the database (col. 5 lines 18-25) including services used in the past (col. 5 line 24), Tanaka does not specifically teach that this history information including past used sites/services is sent to the client terminal.

Art Unit: 2625

Fritsch teaches sending a predetermined number (the number is determined before the user logs into the system, thus predetermined before the current session) past used sites/services to the client terminal for display (Fig. 2A & 2B; col. 6 lines 49-61).

It would have been obvious that the history stored in Tanaka would be useful to the user so they could see and access sites they have used before. The motivation for providing such history to the user would have been to allow the user to use services they have used before without having to remember how to locate them on the network and allows faster access if the user is in a hurry.

Regarding claim 35, the structural elements of claim 36 perform all of the method steps of method 35 and thus 35 is rejected for reasons analogous to claim 36.

Regarding claims 19 and 20, these claims, while indefinite as discussed above, include some of the main features of claim 36 and are interpreted to be claiming substantially the same subject matter for prior art reasons. Thus, Tanaka in view of Fritsch teach all of the limitations as discussed in claim 36.

Regarding claims 28 and 21, Tanaka teaches **server sends map information showing said nearest printing agent printer site based on said location information** (col. 7 lines 1-3, see more description in col. 6 as well).

Regarding claims 30 and 23, Tanaka teaches **server retrieves the current location of said client terminal based on said location information** (col. 7 lines 24-25, wherein a current location is detected based on user location information, also col. 8 lines 3-4), **and thereafter, retrieves printing agent printer site nearest to said current location** (col. 8 lines 13-30).

Art Unit: 2625

5. Claims 22 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka and Fritsch as applied to claims 19 and 20 above, and further in view of Britt et al. (US 6647267).

Regarding claims 22 and 29, Tanaka does not specifically teach the location information being by GPS.

However, Britt teaches **server receives GPS information from said client terminal** (col. 2 line 30, Fig. 1).

It would have been obvious to one of ordinary skill in the art that that Tanaka's system of sending location information and being able to provide maps could have been done with GPS. The motivation for doing so would have been to provide a well-known and exact system of location determination. Further, Tanaka also teaches receiving the current location of the user's mobile device (col. 7 lines 23-26), thus it would have also been obvious to use GPS for this to determine exact location of the user.

6. Claims 31 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka and Fritsch as applied to claims 19 and 20 above, and further in view of Minari (US 6809831).

Regarding claims 31 and 24, while Tanaka teaches the outputting of a print job and letting the user know where the print job is outputted (col. 6 lines 50-53), the combination of Tanaka and Fritsch does not specifically teach sending the printing results to the client terminal.

Minari teaches sending printing results to a user (Fig. 8, wherein the print result is sent to the printer controller and from there to the user application at the host computer).

It would have been obvious to one of ordinary skill in the art that letting a user know the results of their print job would have been beneficial to system where the user notified where the print job is being output. The motivation for doing so would have been to only have the user travel to the site to pick up the job when the job has been output correctly and when the job has not been output correctly, notifying the user so they do not travel and waste time to retrieve a job that hasn't been output correctly.

7. Claims 32 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka and Fritsch as applied to claims 19 and 20 above, and further in view of Kawai et al. (US 6404994).

Regarding claims 32 and 25, while the combination of Tanaka and Fritsch teach fees in a printing service system (Tanaka Fig. 10, wherein the goods of the service station [in this example printing services]), the combination does not specifically teach how the user pays for the printing services including that the **server automatically debits a specified account for an agent printing fee**.

Kawai teaches **server** (copier 18 includes printing server functionality as shown in Fig. 4) **automatically debits a specified account for a printing fee** (col. 5 lines 15-20, wherein charging device automatically debits a prepaid card, which is the user account information).

It would have been obvious that the automatic payment system of Kawai could have been used to pay for the printing services specified in the combination. The motivation for doing so would have been to allow users quick and automatic debit of their accounts so they would not have to deal with a person (thus quicker) or pay in cash (thus easier). Further, Kawai teaches the

Art Unit: 2625

charging system is typically at a store (col. 4 line 12) and the printing services rendered in the combination are taught as implement able in a store (see Tanaka Fig. 11A, wherein the stores have specific prices for services).

8. Claims 26 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka and Fritsch as applied to claims 19 and 20 above, and further in view of Satomi et al. (US 2004/0039641).

Regarding claims 26 and 33, the combination of Tanaka and Fritsch do not specifically teach placing adds on printouts or giving discounts accordingly.

However, Satomi teaches printing that includes an advertisement to a printer in accordance with an advertisement-included printing specification and discounts a printing fee in accordance with the printing that includes an advertisement (abstract and Figs. 17, 29, 53-56, 70, 77, 79 and their descriptions – other pertinent sections of the reference should be also reviewed, given figures just examples).

It would have been obvious to one of ordinary skill in the art to be able to include advertisements in the printouts as done in Satomi. A motivation for doing so would have been the clear motivation of reducing cost for the user and securing advertising space for marketers.

9. Claims 27 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka and Fritsch as applied to claims 19 and 20 above, and further in view of Hanzawa (US 5506661).

Regarding claim 18, which depends from claim 10, while the combination teaches fees in a printing service system (Tanaka Fig. 10, wherein the goods of the service station [in this

Art Unit: 2625

example printing services]), the combination does not specifically teach sending the client the fee in accordance with the printing results.

Hanzawa teaches that it is well known in the art to notify a user of the cost of printing once the printing has been completed (col. 1 lines 19-22, wherein the fee is calculated after printing, and col. 1 line 11, wherein it is displayed for a user).

It would have been obvious to one of ordinary skill in the art that a printing fee for the print job could have been calculated and sent to the user in the combined system. The motivation for notifying a user of the cost of a printed print job would have been to allow the user to have the proper payment for the print job when they arrived at the service station of Tanaka to pick up their print job.

Response to Arguments

10. Applicant's arguments filed 2/28/06 have been fully considered but they are not persuasive.

With respect to applicant's arguments that Fritsch does not specifically teach the newly presented claim limitations in claims 19 and 20.

Regarding the predetermined number, since the number of items to be displayed is known before the user logs in for a session, the number is predetermined before the session. Regarding a list of most recently used, Fritsch displays the full list of what users have used/purchased in the past, thus displaying all (including the most recently used items). Regarding whether the items will be selected again, one reason Fritsch can display the items is for a user to be able to select them again if need be (e.g. to get product information again or the like). Thus, the idea of

Art Unit: 2625

presenting a user with a predetermined list of services previously used is well known in the art and would have been obvious to combine as outlined below.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lucas Divine whose telephone number is 571-272-7432. The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on 571-272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lucas Divine
Examiner
Art Unit 2625

Ljd


KING Y. POON
PRIMARY EXAMINER